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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,086	11/01/2001	Gary Mack Jennings	406-Div	1207
2292	7590	04/07/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			TRINH, MINH N	
			ART UNIT	PAPER NUMBER
			3729	

DATE MAILED: 04/07/2004

AP

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/002,086

Applicant(s)

JENNINGS ET AL.

Examiner

Minh Trinh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. "A pin service "(claims 2-30, 32-45) should be changed to: --The--, in order to readable on the dependent claim formats as so to be consistent with the scope as defined in the preamble of claims 1 and 31 (independent claims).

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Following are examples:

The scope of claims 2-30 and 32-46 should be revised to read on "the tool kit" instead of a pin service (see also paragraph 1).

It is not clear whether "a head piece having a plurality of pins holes" (see claim 2, line 2 and claim 31, lines 4-5) is the same as a tip 252 as described in the applicants' disclosure (refer to page 9, paragraphs 2, lines 3-4). Therefore, it is suggested the claim languages should be revised to be consistent with that as described in the specification as so to clarify the intended claim feature.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 5, 24, 31 and 40, as best understood are rejected under 35 U.S.C. 102(b) as being anticipated by Chisholm (US 4,206,543).

As applied to claims 1 and 31, Chisholm discloses the tool kit as claimed by the present invention including a handle 38, a pin insertion tool 30 attached to the handle 38, said pin insertion tool including pin locating means 10 having a plurality headpieces for specifying a specific position for a pin connector 12 to be inserted into the back plane (see Figs. 3-4, and the discussed at col. 4, lines 1-10).

\* It is note that the limitation recites such as: “ for specifying a specific position for a pin connector to be inserted into the back plane” (claim 1, line 4-5), etc., is intended use limitation which does not further limit the claimed tool kit. Since the prior art meets every aspect structural element of the present claim therefore it is capable of performing the same functionally intended use as described above.

As applied to claim 2, as best understood, Chisholm discloses the pin locating means including a head piece 10 having a plurality holes associated therefrom (see Fig. 3) noted that reference 10 of the applied art is readable as “a head piece” of the present invention.

As applied to claim 3, Chisholm discloses the guiding means 32 (see col. 4, lines 10). Noted that for guiding . . . into the backplane is functional intended use, and the

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applied art is capable of performing the functional as described above (see the discussion \* above).

Limitation of claim 5 is also satisfied by Chisholm.

As applied to claim 24, Chisholm shows a pin seating tool 34 attached to the handle 38 (see Fig. 3) Note that the limitation recites: "for pushing a replacement pin . . . backplane" (see claim 24, lines 2-3) is intended use limitation (see the discussion in \* above).

Limitation of claim 31 is also satisfied as set forth above.

As applied to claim 40, Chisholm shows a pin seating tool 34 attached to the handle 38 (see Fig. 3) Note that the limitation recites: "for pushing a replacement pin . . . backplane" (see claim 40, lines 2-3) is intended use limitation (see the discussion in \* above).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6-7, 13, 21-23, 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chisholm.

As applied to claims 6-7, Chisholm does not teach the pin locating means comprising a plurality of headpieces. However, it would have been an obvious matter of

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design choice to choose any number of head pieces since applicant has not disclosed that these features are critical, patentably distinguishing features and it appears that the invention would perform equally well with at least one head piece as shown by the applied art (see Chisholm's Figs. 3-5).

As applied to claim 13, Chisholm discloses the limitation of claim 13 including a guiding means 32 (see Fig.3).

As applied to claims 21 and 37, regarding the dimension of the handle being the same as a depth of the telecommunication device. It would have been an obvious matter of design choice to choose any desired size including a length of an associated handle since applicants have not disclosed that the exact length is patentably distinguishing features and it appears that the invention would perform equally well with the handle's length configurations taught by Chisholm (see Fig. 3).

As applied to claim 22 and 38, regarding the handle telescopable from short to long extended configuration. This concept is considered old and well known in the art. Therefore, one having an ordinary skill in the art would know to use such handle telescopable configuration as described above dependent upon the application requirements.

As applied to claim 23 and 39, it would have been an obvious matter of design choice to choose any desired handle configurations including the described above since applicants have not disclosed that the exact handle telescopable/ boroscope is patentably distinguishing features and it appears that the invention would perform equally well with the handle configurations as taught by Chisholm (see Fig. 3).

***Allowable Subject Matter***

8. Claims 4, 8-12, 14-20, 25-30, 32-36 and 41-46 would be allowable if rewritten to overcome the claim objections and the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. The reasons for the indication of allowable subject matter as follows: that the prior art alone or in combination with other references does not teach or fairly suggest the specific limitations as recited in these dependent claims (i.e., see claim 4, lines 2-5, claim 9, lines 1-2, claim 11, lines 2-5, and claim 30, lines 5-12 and that as recited in claim 32).

***Prior Art References***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art references are cited for their teaching of tool for inserting pin connector into a headpiece or PWB.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (703) 305-2887. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



M- Trinh

Patent Examiner Group 3729

mt